



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,569	11/09/2000	Makiko Endo	35.C14920	2291

5514 7590 10/10/2002
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER
NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
1774	10

DATE MAILED: 10/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/708,569

Applicant(s)

ENDO ET AL.

Examiner

Kimberly T. Nguyen

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2002.
- 2a) ☒ This action is FINAL.
- 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-36,39,50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-36,39,50 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

This action is in response to the amendment submitted on July 23, 2002.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Due to Applicants' remarks, the previous rejections of claims 23-27, 34-35, 39, and 51 under 35 USC 112, 2nd paragraph are withdrawn.

The term "main" in the phrase "the main portion" in claim 26 is a relative term which renders the claim indefinite. The term "main" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

Claims 25, 30-33, 36, 39, and 50-51 are rejected under 35 U.S.C. 102(e) as being anticipated by EP 900, 831 A2 (EP '831) as previously stated in the Office Action submitted on April 23, 2002.

Claim Rejections - 35 USC § 103

Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 900, 831 A2 (EP '831) as previously stated in the Office Action submitted on April 23, 2002.

Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 900, 831 A2 (EP '831) as previously stated in the Office Action submitted on April 23, 2002.

Art Unit: 1774

As to the newly added limitation that the “coloring material is provided on a coloring medium” and that the “coloring material...forming a main portion of the image” in claim 26, EP '831 shows that the dye is provided on fine particles to form an image excellent in rubbing or scratching resistance (page 5, lines 46-49).

As to the newly added limitation that “a ratio of the coloring material to the fine particles is larger” in claim 27, such a ratio is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the ratio, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. ratios) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are result effective as they control the amount of color on the recorded image. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the ink-jet recorded image with the limitations of the ratio since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 900,831 A2 (EP '831) in view of EP 776,950 A2 (EP '950) as previously stated in the Office Action submitted on April 23, 2002.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 900,831 A2 (EP '831) as previously stated in the Office Action submitted on April 23, 2002.

Art Unit: 1774

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 900,831 A2 (EP '831) as previously stated in the Office Action submitted on April 23, 2002.

Response to Arguments

Applicants' argument filed July 23, 2002 have been fully considered but they are not persuasive.

On pages 11-13, Applicants argue that the dye that is present near the fine particles of Miyabayashi EP '831 is taken in the polymer aggregates and not *absorbed* onto fine particles as in the instant invention. The Examiner is not persuaded because Miyabayashi shows on page 5, lines 46-51 that though part of the dye is penetrated into the recording medium, a part of the dye is also incorporated into the fine particles.

On pages 13-14, Applicants argue that Miyabayashi does not teach nor suggest that the adsorbed coloring material is in a monomolecular state. However, Miyabayashi does not teach away from the dye being adsorbed into the particles and Applicants specifically admit in the last paragraph of page 4 of the specification that "it is known that the coloring material should be maintained in a monomolecular film state" in order to obtain an image of high saturation.

On page 14, Applicants argue that Shimomura EP '950 does not remedy the deficiencies of the Miyabayashi reference. The Examiner is not persuaded because Shimomura is used *in combination with* Miyabayashi to show that it is obvious to use anionic or cationic colorants and to use fine particles having a polarity which is opposite to that of the colorant.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1774

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen
Examiner
October 9, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

TECHNOLOGY CENTER 1700
SUPERVISORY PATENT EXAMINER
CYNTHIA H. KELLY

Cynthia Kelly